

**REMARKS**

Claims 1-18 are pending.

Applicant thanks the Examiner for the telephone interview on March 30, 2004, which focused primarily on claim 1. Applicant appreciates the Examiner's comments, and has incorporated the Examiner's suggestions into the present Response. Applicant has also amended the Abstract as requested by the Examiner.

**Claims 1-14**

Claim 1 stands rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,877,758 to Boden et al. ("Boden"), U.S. Patent No. 5,877,758 to Seybold ("Seybold"), and U.S. Patent No. 5,918,014 to Robinson ("Robinson"). However, it is submitted that this combination of references is improper for the following reasons.

According to MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

As Applicant has previously argued in earlier Responses and as is reiterated further below, the combination of references is improper. Further supporting this argument is the fact that the Examiner has combined multiple references to render a single element obvious, and this was done several times for claim 1 alone.

For example, claim 1 recites the element of "selecting a component in connection with all matters of the client." To render this single element obvious, the Examiner has used Seybold ("selecting a component"; Office Action, para. 6), Robinson ("in connection with all matters"; OA, para. 7), and Boden ("of the client"; OA, para. 5).

In another example, claim 1 recites the element of "selecting a filter for filtering items for the selected client, matters and component." To render this single element obvious, the Examiner has used Robinson ("selecting a filter for filtering items"; OA, para. 7), Boden ("for the selected client"; OA, para. 5), Robinson again ("matters"; OA, para. 7), and Seybold ("for the component"; para. 6).

In still another example, claim 1 recites the element of "selecting a component in connection with the selected group of matters." To render this single element obvious, the Examiner has used Seybold ("selecting a component in connection"; OA, para. 6) and Robinson ("in connection with the selected group of matters"; OA, para. 7).

Applicant submits that the Examiner has simply taken unrelated phrases from the various references and combined them using Applicant's disclosure as a blueprint without any teaching or suggestion in the references themselves.

The case law forbids this type of combination by requiring that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000).

Furthermore, Applicant respectfully submits that the Office action simply takes bits and pieces of information from each reference and pieces them together like a jigsaw puzzle using the Applicant's disclosure as a blueprint. However, the case law makes it clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *Id.* It is respectfully submitted that the only way the cited references could be pieced together to defeat patentability is indeed to use Applicant's disclosure as a blueprint, as is clearly illustrated by the use of multiple references to render a single element of claim 1 obvious.

Accordingly, the combination of references is improper. As has been stated in previous Responses, there is simply no teaching or suggestion in any of the references for the combinations used by the Examiner.

The Office action states that "[t]he Boden, Seybold, and Robinson references come from related technologies. Boden, Seybold, Robinson, and Bowen teach the use of

computers, the use of networks, the viewing and updating of data, the use of information, the use of users of the system, and the use of applications and Boden and Robinson teach the use of logging on. It is clear, that the references of Boden, Seybold, Robinson, and Bowen use similar technologies. Furthermore, Seybold describes a collaborative management tool ...." (Office action, para. 26).

The Applicant respectfully submits that the preceding paragraph fails to meet the legal requirement embodied in MPEP § 2143.01, because the cited prior art combination fails to "suggest[ ] the desirability of the combination." In fact, if the above references are properly combinable simply because they use "similar technologies," which the Office action seems to imply, then it is difficult to imagine a combination of computer-related references that could not be asserted against Applicant's application. While the Examiner describes what each reference teaches, he fails to make particular findings as to why the references are combinable. However, the Examiner is required to make particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000).

While Applicant agrees that each reference teaches the use of computers (as do literally thousands of patents), the references use the computers to address problems in different computer fields. For example, Boden is directed to an apparatus and method for process modeling using both a web server and a workflow server in process definition. (See Abstract). "During buildtime, a process definition in the language of some workflow process modeler is fed to transform  $f(p)$ , which provides a translate process definition into a hypertext markup language (HTML) representation of the workflow process. A user utilizing the facilities of an HTTP server may operate a web browser to request that HTTP server provide the HTML process definition to enable the user to create, or read and modify, the process definition as desired. The result is then fed through an inverse transform  $f'(p)$  to a workflow server in the language of that server, for invocation and execution during runtime of the programs defined during buildtime." (Abstract).

Seybold is directed to "[a] control device for adjusting multiple parameters associated with an element or item of a user interface in an easy and intuitive manner." (Abstract). "A slider control can be used to change the format or appearance of a timescale presented by the user interface. By using a single visual interface control, a slider control, a time-based

scaling of a given view can be easily switched between predefined timescale settings for the timescale." (Abstract).

Robinson is directed to automated collaborative filtering in world wide web advertising. More specifically, Robinson "combines techniques for: determining the subject's community, and determining which ads to show based on characteristics of the subject's community. The information used to determine whether a given individual should be in the subject's community is gleaned from the individual's activities in the interactive medium." (Abstract).

The case law forbids this type of combination by requiring that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000). Applicant respectfully submits that no such findings have been presented in the Office action to support the combination of references. There is absolutely no finding as to why Boden's method for process modeling using both a web server and a workflow server in process definition would be properly combined with Seybold's control device for adjusting multiple parameters associated with an element or item of a user interface in an easy and intuitive manner, or Robinson's automated collaborative filtering in world wide web advertising.

In response to Applicant's argument that the Examiner has used a hindsight-based obviousness analysis, the Examiner states that "it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from Applicant's disclosure, such a reconstruction is proper." (citing *In re McLaughlin*) (OA, para. 27).

However, the Federal Circuit has stated:

Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the tempting but forbidden zone of hindsight, . . . when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then accepted wisdom in the field. . . . Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. . . . In this case, the Board fell into the hindsight trap. . . . **The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.**

*In re Dembiczak*, 50 USPQ 2d 1614, 1616-17 (Fed. Cir. 1999) (quotations omitted) (emphasis added). Applicant respectfully submits that the Examiner's rebuttal fails to address Applicant's argument that the Examiner's failure to render a showing of a teaching or motivation to combine the prior art references and is the essence of hindsight, as recited in *Dembiczak*.

Accordingly, it is respectfully submitted that claim 1 is allowable over the cited references for at least the reasons stated above. Claims 2-14 depend from and further limit claim 1 and therefore are allowable for at least the same reasons as claim 1.

#### Claims 15-18

Claim 15 stands rejected under § 103(a) as being unpatentable over U.S. Patent No. 6,182,080 to Clements ("Clements"), U.S. Patent No. 6,253,234 to Hunt et al. ("Hunt"), Boden, and Robinson. However, it is submitted that this combination of references is improper for the following reasons.

As stated previously, according to MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

As Applicant has previously argued in earlier Responses and as is reiterated further below, the combination of references is improper. Further supporting this argument is the fact that the Examiner has combined multiple references to render a single element of claim 15 obvious.

For example, claim 15 recites the element of "instructions for allowing the second user to view, add, or modify any one of the documents in the repository according to the authorization of the second user with respect to a particular matter." To render this single element obvious, the Examiner has used Clements ("instructions"; OA, para. 19), a different portion of Clements ("for allowing the second user"; OA, para. 19), Boden ("to view, add, or modify"; OA, para. 21), Clements again ("any one of the documents in the repository"; OA, para. 19), Boden again ("according to the authorization"; OA, para. 21); Clements yet again ("of the second user"; OA, para. 19), and Robinson ("with respect to a particular matter"; OA, para. 22). Multiple references are even used for sub-elements of claim 15 (e.g., "according to the authorization of the second user").

For reasons described in detail with respect to claim 1, Applicant submits that the Examiner has clearly taken unrelated phrases from the various references and combined them using Applicant's disclosure as a blueprint without any teaching or suggestion in the references themselves.

As stated above, the case law forbids this type of combination by requiring that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for

combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000).

Similar to the rejection of claim 1, the Office action states that "the Clements, Hunt, Boden, and Robinson references come from related technologies. Clements, Hunt, Boden, and Robinson teach the use of computers, the use of databases, the use of networks, the updating of data, the use of information, the use of users of the system, and the use of applications and Clements, Boden, and Robinson teach the viewing of data, the use of categories, and the use of documents. It is clear, that the Clements, Hunt, Boden, and Robinson references use similar technologies ...." (Office action, p. 23, para. 29).

The Applicant respectfully submits that the preceding paragraph fails to meet the legal requirement embodied in MPEP § 2143.01, because the cited prior art combination fails to "suggest[ ] the desirability of the combination." While the Examiner describes what each reference teaches, he fails to make particular findings as to why the references are combinable. However, the Examiner is required to make particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000).

While Applicant agrees that each reference teaches the use of computers (as do literally thousands of patents), the references use the computers to address problems in different computer fields. For example, Clements is directed to the storage of multiple documents and a tracking log within a single file. (Abstract). "More specifically, the present invention provides a convenient way to organize multiple documents and store them within a single file in a manner that facilitates exchange of the collection of documents and collaboration on the collection by a group of individuals." (Abstract).

Hunt is directed to shared web page caching at browsers for an intranet. More specifically, "[e]ach client in an intranet includes at least the minimum functionality required to serve a remote request such as an HTTP request. Existing browsers within the intranet may share their collective local caches to form a scalable cache. The intranet proxy routes page requests from one client within the intranet to another when a local cache within the intranet contains a current copy of the requested page. A trust protocol insures that clients serving as caches may be trusted by the proxy, while a refresh mechanism such as a time-out policy ensures that the page is reloaded after a predetermined period of time." (Abstract).

As stated previously in greater detail, Boden is directed to an apparatus and method for process modeling using both a web server and a workflow server in process definition, and Robinson is directed to automated collaborative filtering in world wide web advertising.

The case law forbids this type of combination by requiring that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000). Applicant respectfully submits that no such findings have been presented in the Office action to support the combination of references. There is absolutely no finding as to why Clements' storage of multiple documents and a tracking log within a single file would be properly combined with Hunt's shared web page caching at browsers for an intranet, Boden's method for process modeling using both a web server and a workflow server in process definition, or Robinson's automated collaborative filtering in world wide web advertising.

Furthermore, Applicant respectfully submits that the Office action simply takes bits and pieces of information from each reference and pieces them together like a jigsaw puzzle using the Applicant's disclosure as a blueprint. However, the case law makes it clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *Id.* It is respectfully submitted that the only way the cited references could be pieced together to defeat patentability is indeed to use Applicant's disclosure as a blueprint.

In response to a similar argument made previously by Applicant, the Office action states that "it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's



disclosure, such a reconstruction is proper." (Office action, para. 30). Applicant respectfully submits that this fails to address Applicant's argument that the Examiner's failure to render a showing of a teaching or motivation to combine the prior art references is the essence of hindsight, as recited in *Dembiczak*.

Accordingly, it is respectfully submitted that claim 15 is allowable over the cited references for at least the reasons stated above. Claims 16-18 depend from and further limit claim 15 and therefore are allowable for at least the same reasons as claim 15.

Conclusion

Therefore, it is respectfully submitted that independent claims 1 and 15 are in condition for allowance. Dependent claims 2-14 and 16-18 depend from and further limit independent claims 1 and 15 and therefore are allowable as well.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

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